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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

SONOS, INC.,

Plaintiff,

v.

GOOGLE LLC,

Defendant.

Case No. 3:21-cv-07559-WHA

**SONOS, INC.'S MOTION FOR LEAVE  
TO FILE THIRD AMENDED  
COMPLAINT**

Date: May 12, 2022

Time: 8:00 a.m.

Place: Courtroom 12, 19<sup>th</sup> Floor

Judge: Hon. William Alsup

Second Amended Complaint Filed:  
February 23, 2021

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**NOTICE OF MOTION**

TO ALL PARTIES AND THEIR ATTORNEYS:

PLEASE TAKE NOTICE that on May 12, 2022 at 8:00 a.m., or as soon thereafter as may be heard before the Honorable Judge William Alsup in Courtroom 12 on the 19th Floor of the United States District Court for the Northern District of California, San Francisco Courthouse, 450 Golden Gate Avenue, San Francisco, CA 94102, Plaintiff Sonos, Inc (“Sonos”) will, and hereby does, move this Court for an order granting Sonos leave to file a Third Amended Complaint. This motion is based on this Notice of Motion, the accompanying Memorandum of Points and Authorities, the Declaration of Cole B. Richter (“Richter Decl.”), and exhibits thereto, all documents in the Court’s file, and such other written or oral evidence and argument as may be presented at or before the time this motion is heard by the Court.

**STATEMENT OF THE RELIEF REQUESTED**

Pursuant to Rule 15(a)(2) and Rule 15(d) of the Federal Rules of Civil Procedure and the Court’s order (Dkt. 156), Sonos requests that this Court grant Sonos leave to file a Third Amended Complaint (“TAC”). The redlined version of the proposed TAC is attached as Ex. 8 to the Richter Decl., along with ten (10) new exhibits to the TAC.

**MEMORANDUM OF POINTS AND AUTHORITIES**

**I. STATEMENT OF RELEVANT FACTS**

Amidst a backdrop of over five years of Sonos and Google discussing the breadth and depth of Sonos’s patent portfolio vis-à-vis the accused products, and an ongoing International Trade Commission litigation concerning certain Sonos patents and Google’s accused products, on September 28, 2020, Sonos provided Google with a pre-filing copy of the original complaint in this matter, which alleged that Google directly and indirectly infringes, *inter alia*, U.S. Patent Nos. 10,469,966 (“’966 Patent”) and 10,779,033 (“’033 Patent”).<sup>1</sup> Dkt. 136 (Joint Case Management Statement) at 1. Before midnight that same day, and shortly before Sonos filed its

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<sup>1</sup> The Complaint also alleged infringement of U.S. Pat. No. 9,967,615 (“’615 Patent”), which was not at issue in Google’s motion to dismiss, as well as other patents that have since been withdrawn from the case.

1 complaint in the Western District of Texas, Google filed its own complaint in this District seeking  
2 declaratory judgment of non-infringement. *Google LLC v. Sonos, Inc.*, Case No. 3:20-cv-06754-  
3 WHA (N.D. Cal. Sept. 28, 2020) (hereinafter, “DJ Case”), Dkt. 1. The Court stayed Google’s DJ  
4 Case after finding that Google’s DJ Case was an exception to the first-to-file rule. DJ Case,  
5 Dkt. 36 at 4 (“Google’s choice of forum is entitled to no weight.”).

6 While Google’s case was stayed, Sonos continued to litigate its claims in the Western  
7 District of Texas, which included (i) Sonos providing Google with a draft First Amended  
8 Complaint on January 8, 2021, the purpose of which was to set forth Google’s infringement of  
9 U.S. Patent No. 10,848,885 (“’885 Patent”), which had just issued, and (ii) Sonos filing, over a  
10 month later, this same First Amended Complaint. Dkt. 49. Shortly thereafter, on February 18,  
11 2021, Sonos filed a Second Amended Complaint—which is the operative complaint here—the  
12 purpose of which was to withdraw claims of infringement for a patent not at issue in this motion.  
13 Dkt. 50.

14 Although Google answered Sonos’s original Complaint, and despite the Second Amended  
15 Complaint being substantively identical to the original Complaint vis-à-vis the ’966 and ’033  
16 Patents, Google, on March 9, 2021, changed course and moved to dismiss Sonos’s claims of  
17 willful and indirect infringement for the ’966, ’033, and ’885 Patents.<sup>2</sup> Dkt. 55. When the Texas  
18 action was transferred to this Court on September 27, 2021 the Texas court had not ruled on  
19 Google’s motion. Dkt. 117. Google failed to prompt or otherwise inquire as to the motion’s  
20 status after the motion had languished on the Texas court’s docket for over six months. So, when  
21 the case was transferred to this District, the Texas Court had not addressed Google’s motion to  
22 dismiss.

23 Once the Texas Action was transferred to this District, this Court held a case management  
24 conference on October 7, 2021. During that conference, Google informed the Court that it  
25 intended to refile its motion to dismiss that was originally filed in the Western District of Texas  
26 on March 9th. Ex. 1 at 17:1-18:3. Accordingly, this Court ordered Google to “refile those

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27 <sup>2</sup> Google did not move to dismiss Sonos’s willfulness or indirect infringement claims for the  
28 ’615 Patent.

1 motions....” *Id.* at 18:2-3. Google waited another two months, however, before submitting a  
 2 precis request on December 9, 2021, and ultimately a motion to dismiss on January 10, 2022,  
 3 seeking to dismiss Sonos’s claims of willful and indirect infringement for the ’966, ’033, and  
 4 ’885 Patents. Dkts. 125, 138.

5 On March 16, 2022, the Court granted Google’s motion, dismissing Sonos’s claims of  
 6 willful and indirect infringement for the ’966, ’033, and ’885 Patents without prejudice, but  
 7 expressly stating “Sonos will be allowed to make the willfulness allegations either by way of a  
 8 counterclaim in the declaratory relief action or by way of amendment in the Texas action now  
 9 that it has come to this district.” Dkt. 156 at 10; *see also id.* (“It will be allowed to amend to try  
 10 again.”).

## 11 **II. LEGAL STANDARD**

12 Rule 15(a)(2) of the Federal Rules of Civil Procedure provides that leave to amend shall  
 13 be freely given “when justice so requires.” The Ninth Circuit has instructed that “this policy is to  
 14 be applied with extreme liberality.” *Owens v. Kaiser Found. Health Plan, Inc.*, 244 F.3d 708,  
 15 712 (9th Cir. 2001) (quoting *Morongo Band of Mission Indians v. Rose*, 893 F.2d 1074, 1079 (9th  
 16 Cir. 1990)).

17 In this regard, courts should grant leave to amend absent (i) undue delay, bad faith, or  
 18 dilatory motive, (ii) repeated failure to cure deficiencies, (iii) undue prejudice to the opposing  
 19 party, or (iv) futility. *Foman v. Davis*, 371 U.S. 178, 182 (1962); *Fluidigm Corp. v. IONpath,*  
 20 *Inc.*, No. C 19-05639 WHA, 2020 WL 1433178, at \*1 (N.D. Cal. Mar. 24, 2020). In fact,  
 21 “[c]ourts may decline to grant leave to amend **only if** there is **strong** evidence” of one of the  
 22 *Foman* factors. *Sonoma Cnty. Ass’n of Retired Emps. v. Sonoma Cnty.*, 708 F.3d 1109, 1117 (9th  
 23 Cir. 2013) (emphasis added). In evaluating a motion to amend, all inferences should be drawn in  
 24 favor of granting the motion. *Griggs v. Pace Am. Grp., Inc.*, 170 F.3d 877, 880 (9th Cir. 1999).

## 25 **III. ARGUMENT**

26 Pursuant to the liberal policy for allowing amendments under Rule 15(a)(2), this Court  
 27 should grant Sonos’s leave to amend its Second Amended Complaint and file a Third Amended  
 28 Complaint because Google cannot point to any evidence—much less **strong** evidence—of any

1 *Foman* factor that would weigh against amendment.

2 **A. Sonos's Motion Is Timely & In Good Faith**

3 The first *Foman* factor – whether there is strong evidence of “undue delay, bad faith or  
4 dilatory motive on the part of the movant” – does not weigh against granting leave to amend.  
5 *Foman*, 371 U.S. at 182. In this respect, Google cannot establish any undue delay, bad faith, or  
6 dilatory motive.

7 Sonos promptly and diligently filed this motion 14 days after the Court granted Google's  
8 motion to dismiss and provided Sonos with permission to move for leave to amend its complaint.  
9 Dkt. 156 at 13. To the extent that Google argues that Sonos's proposed amendment comes too  
10 late in the course of this litigation, any delay is of Google's making. In this regard, Google first  
11 moved, on March 9, 2021, while this action was in the Western District of Texas. But Google  
12 failed to prompt or otherwise inquire as to the motion's status after the motion had languished on  
13 the Texas court's docket for over six months. This left the motion unresolved by the time the  
14 action was transferred to this District on September 29, 2021. To make matters worse, Google  
15 waited until December 9, 2021 to begin the motion to dismiss process, despite informing the  
16 Court of Google's intent to refile over two months prior. Accordingly, Google cannot establish a  
17 strong showing of undue delay or dilatory motive.

18 Sonos's motion is filed in good faith. Indeed, Sonos's proposed TAC follows this Court's  
19 first articulation of its “ground rules” to adequately plead willful and indirect infringement.  
20 Dkt. 156 at 13 (certifying under 28 U.S.C. § 1292(b) because “reasonable minds may differ as to  
21 the ground rules set forth above for pleading willfulness and indirect infringement ...”); *Sonoma*  
22 *Cnty. Ass'n of Retired Emps.*, 708 F.3d at 1117-18 (“[A court] may grant leave to amend in  
23 situations where the controlling precedents changed midway through the litigation.”). In this  
24 respect, Sonos's proposed TAC addresses the very topics that the Court sanctioned in its order.  
25 Dkt. 156 at 10 (“Google commenced its own declaratory relief claim first.... Sonos should be  
26 allowed to plead the infringer's knowledge of the patents and that the infringer has had sufficient  
27 time to analyze the accused product vis-à-vis those patents (along with other specifics needed to  
28 show willfulness).”); *see also id.* (“The foregoing ground rules concerning the adequate pleading



1 of willful infringement and enhanced damages apply with parallel force to the parallel issues for  
 2 indirect infringement.”). Thus, Sonos’s motion is filed in good faith, as its amended complaint  
 3 directly responds to the Court’s pleading “ground rules.”

4 In view of the foregoing, there is no evidence of undue delay, bad faith, or dilatory  
 5 motive.

6 **B. There Were No Prior Failures to Cure**

7 The second *Foman* factor – whether there is strong evidence of “repeated failure to cure  
 8 deficiencies by amendments previously allowed” – also does not weigh against the liberal policy  
 9 for granting leave to amend. *Foman*, 371 U.S. at 182.

10 Google cannot establish any repeated failures to cure because there were none. In fact,  
 11 this is the first time the Court has dismissed Sonos’s claims of willful and indirect infringement  
 12 for the ’966, ’033, and ’885 Patents. As such, there was no prior opportunity (or need) for Sonos  
 13 to “cure” these claims, much less any “repeated failure” by Sonos to do so.

14 Thus, there is no evidence of repeated failure to cure deficiencies by amendments  
 15 previously allowed.

16 **C. There Is No Undue Prejudice to Google**

17 The third *Foman* factor—whether there is strong evidence of “undue prejudice to the  
 18 opposing party by virtue of allowance of the amendment”—further does not weigh against the  
 19 policy for granting leave to amend. *Foman*, 371 U.S. at 182. The party “opposing amendment  
 20 bears the burden of showing prejudice,” which Google cannot do here. *DCD Programs, Ltd. v.*  
 21 *Leighton*, 833 F.2d 183, 187 (9th Cir. 1987).

22 For well over a year, Google has been on notice of the facts and theories underlying  
 23 Sonos’s proposed amended complaint and has had ample opportunity to conduct discovery  
 24 related thereto. As such, Google cannot credibly argue that it is surprised or otherwise prejudiced  
 25 by Sonos’s proposed amendments. *See, e.g., Howard Rice Nemerovski Canady Falk & Rabkin v.*  
 26 *Total Tech., Inc.*, No. C 06-0426 CW, 2006 WL 2850047, at \*3 (N.D. Cal. Oct. 5, 2006)  
 27 (“Prejudice typically arises where the opposing party is surprised with new allegations which  
 28 require more discovery or will otherwise delay resolution of the case.”).

1 For instance, in response to Google’s interrogatory number 14 requesting that Sonos  
2 “[s]tate all bases for [its] contention, if any, that Google’s infringement has been willful,” Sonos  
3 provided a 17-page, detailed narrative explaining the bases for Sonos’s willfulness claims on  
4 September 7, 2021. *See* Ex. 2, Sonos, Inc.’s Objections and Responses to Google LLC’s First Set  
5 of Interrogatories (Nos. 1-20) at 299-314. On January 21, 2022, Sonos provided further detail  
6 regarding Sonos’s willfulness claims in a supplemental response to Google’s interrogatory  
7 number 14. *See* Ex. 2, at 315-16. Many of the same facts and theories articulated in Sonos’s  
8 interrogatory response form the bases for a majority of Sonos’s proposed amendments regarding  
9 willfulness. TAC ¶¶ 17-31, 38-40, 53-65.

10 Moreover, Google’s own conduct forms the bases for several of Sonos’s proposed  
11 amendments regarding willfulness. For example, on September 28, 2020, Google sought  
12 declaratory judgment of non-infringement of the ’966 and ’033 Patents. DJ Case, Dkt. 1. As this  
13 Court reasoned, “when the controversy is initiated by the accused infringer by way of a  
14 declaratory relief action,” the “accused infringer has presumably already studied the patents  
15 versus the accused products, and, indeed, has sufficiently studied them to assert under Rule 11  
16 that the accused product does not infringement the specified patents[.]” Dkt. 156 at 8. Sonos’s  
17 proposed amendments include express pleadings regarding Google’s knowledge and sufficient  
18 analysis of the patents that justified Google seeking declaratory relief before Sonos filed its own  
19 complaint. *See id.* at 10 (“Sonos should be allowed to plead the infringer’s knowledge of the  
20 patents and that the infringer has had sufficient time to analyze the accused product vis-à-vis  
21 those patents ....”); TAC ¶¶ 55-61.

22 As another example, even after Sonos brought claims for infringement of the ’966, ’033,  
23 and ’885 Patents, Google declined to stop infringing these patents and has failed to introduce any  
24 proposed or actual design-around products in an effort to avoid infringement. Nor has Google set  
25 forth any cognizable non-infringement position, despite Sonos propounding an interrogatory  
26 asking for as much on the very first day fact discovery opened (August 7, 2021). Google’s  
27 response to this interrogatory has merely been that Sonos has not established infringement and  
28 that Google’s products do not practice a bulleted list of each and every independent claim

1 element. *See* Ex. 3, Google LLC’s Objections and Responses to Sonos Inc.’s First Set of  
 2 Interrogatories (Nos. 1-20) at 29-47. Sonos’s proposed amendments regarding willfulness  
 3 include express pleadings regarding such conduct as well, which provide the basis for Google’s  
 4 willful infringement of (i) the ’966 and ’033 Patents starting at least from the date Sonos’s  
 5 original suit was filed (September 29, 2020), and (ii) the ’885 Patent starting at least from the date  
 6 Sonos’s Second Amended Complaint was filed (February 23, 2021). TAC ¶¶ 64-65.

7 Similarly, Google has long been aware of the facts and theories that form the bases for  
 8 Sonos’s proposed amendments regarding indirect infringement. In this respect, while this action  
 9 was in the Western District of Texas, Sonos set forth its indirect infringement theories for the  
 10 ’966 and ’033 Patents on December 11, 2020. *See* Ex. 4, Plaintiff Sonos, Inc.’s Preliminary  
 11 Infringement Contentions and Identification of Priority Dates at 6-13. Sonos provided its indirect  
 12 infringement theories for the ’885 Patent on February 17, 2021. *See* Ex. 5, Plaintiff Sonos, Inc.’s  
 13 Supplemental Preliminary Infringement Contentions and Identification of Priority Dates at 3-5.  
 14 Thereafter, on September 10, 2021, Sonos provided its final infringement contentions in the  
 15 Western District of Texas that set forth the facts and theories for Google’s indirect infringement  
 16 of the ’966, ’033, and ’885 Patents. *See* Ex. 6, Plaintiff Sonos, Inc.’s Final Infringement  
 17 Contentions at 7-26. After this action was transferred to this District, once again, Sonos set forth  
 18 the facts and theories for Google’s indirect infringement of the ’966, ’033, and ’885 Patents on  
 19 October 21, 2021. *See* Ex. 7, Sonos, Inc.’s Disclosure of Asserted Claims and Infringement  
 20 Contentions at 6-24.

21 Thus, Google has long been on notice of the facts and theories underlying Sonos’s  
 22 proposed willfulness and indirect infringement amendments and has had ample opportunity to  
 23 obtain discovery related thereto. As such, there is no evidence of undue prejudice to Google.

#### 24 **D. The Amendments Are Not Futile**

25 The fourth *Foman* factor—whether there is strong evidence of “futility of amendment”—  
 26 additionally does not weigh against the liberal policy for granting leave to amend. *Foman*, 371  
 27 U.S. at 182. For this *Foman* factor, “the Court must accept the factual allegations in the proposed  
 28 amended complaint as true and construe them in the light most favorable to Plaintiffs[.]”

1 *Valenzuela v. Best-Line Shades, Inc.*, No. 19-CV-07293-JSC, 2020 WL 4039134, at \*2 (N.D. Cal.  
 2 July 17, 2020). With that mandate in mind, “a proposed amendment is futile only if no set of  
 3 facts can be proved under the amendment to the pleadings that would constitute a valid and  
 4 sufficient claim or defense.” *Sweaney v. Ada Cnty., Idaho*, 119 F.3d 1385, 1393 (9th Cir. 1997).  
 5 Here, Sonos’s proposed amendments are not futile.

6 **1. The Willfulness Amendments Are Not Futile**

7 Google cannot establish that Sonos’s proposed amendments regarding Google’s willful  
 8 infringement of the ’966, ’033, and ’885 Patents are futile.

9 Indeed, consistent with the Court’s guidance in granting Google’s motion to dismiss,  
 10 Sonos has presented factual allegations that Google knew of the ’966, ’033, and ’885 Patents and  
 11 had sufficient time to analyze Google’s accused products vis-à-vis each of these patents prior to  
 12 Sonos bringing each respective claim of infringement. *Compare* TAC ¶¶ 59-63, with Dkt. 156 at  
 13 10 (“Sonos should be allowed to plead the infringer’s knowledge of the patents and that the  
 14 infringer has had sufficient time to analyze the accused product vis-à-vis those patents ....”).  
 15 After all, Google had sufficient time to evaluate the ’966 and ’033 Patents and bring a declaratory  
 16 action for non-infringement before Sonos filed its original complaint. *See, e.g., Mitutoyo Corp. v.*  
 17 *Cent. Purchasing, LLC*, 499 F.3d 1284, 1290 (Fed. Cir. 2007) (finding declaratory action for  
 18 invalidity established defendant had knowledge of patent and was thus “sufficient to meet the  
 19 requirements of Rule 8(a)(2) for pleading a willful infringement claim and avoid dismissal under  
 20 Rule 12(b)(6)”). In this regard, Sonos pleads that in order for Google to have conducted a  
 21 competent and sufficient Rule 11 investigation prior to bringing its DJ Case, it must have (i)  
 22 conferred with Google engineers concerning the operation of the accused products, (ii) reviewed  
 23 the specifications, claims, and file histories of the asserted patents, and (iii) compared the  
 24 operation of the accused products to the claims of the asserted patents and allegedly concluded  
 25 that for one or more reasons the accused products did not practice one or more elements of the  
 26 asserted claims. TAC ¶¶ 59-63. This investigation likely took several hundred hours at a  
 27 minimum, in which case Google had knowledge of these patents and its alleged infringement  
 28 thereof well before September 29, 2020.

Even if Google’s side of the story were taken as true—that Google first learned of these patents the day Sonos sent Google a copy of its draft complaint—Sonos has still pleaded factual allegations that support pre-suit knowledge of the patents and of Sonos’s infringement allegations. It is undisputed that Google received Sonos’s draft complaint and did not give it short shrift. Rather, upon receipt Google and its counsel *immediately* got to work studying the patents, Sonos’s allegations in the draft complaint, and the accused products to support its eventual DJ action. Indeed, Google has already represented to the Court that this special investigation took place. *See* DJ Case, Dkt. 27-3 at 3 (“[U]pon receiving Sonos’s letter, Google investigated Sonos’ allegations, determined that it had a Rule 11 basis for non-infringement, and filed the instant declaratory judgment action.”). Thus, while the Court might consider the typical scenario of one-day notice with a draft complaint to be insufficient because the alleged infringer may not have sufficient time to study the allegations, the scenario here is quite different. The alleged infringer here has already admitted to the Court that it did study the patents, the infringement allegations, and accused products. And, in its own words, it studied them to such an extent as to sufficiently support a federal district court complaint under Rule 11.<sup>3</sup>

Sonos has also presented factual allegations that Google, at a minimum, should have known about the ’966, ’033, and ’885 Patents and Google’s infringement thereof based on the parties’ multi-jurisdictional patent dispute as well as a five-year history where Sonos had repeatedly informed Google of the breadth and depth of Sonos’s patent portfolio and its applicability to the accused Google products, including for patents in the same family as the asserted patents. *Compare* TAC ¶¶ 17-31, 37-40, *with* Dkt. 156 at 9 (“Sonos [has not] adequately alleged that, due to its correspondence and their current multi-jurisdictional patent dispute, Google should have known about the pertinent patents and of infringement.”). These allegations also uniquely support the policy rationale in support of cease-and-desist letters articulated by this Court. Dkt. 156 at 8. In the scenario here, Sonos and Google have been communicating

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<sup>3</sup> In this respect, and to the extent part of the analysis, Google had sufficient time to decide whether to cease infringing. Its DJ complaint represents its affirmative decision to continue infringing in the face of Sonos’s infringement allegations.

1 regarding Sonos’s patent portfolio for *years*. At no point during any of these communications  
2 had Google indicated that it was going to cease infringing. Thus, the unique factual circumstance  
3 here demonstrates that Sonos providing pre-suit notice via a draft complaint did not circumvent  
4 cease-and-desist practice preferred by the Court – indeed, Sonos had already traveled that road  
5 with Google to no avail.

6 The Court must accept these factual allegations as true. Because pre-suit knowledge of a  
7 patent and infringement thereof, as well as willful blindness to the same, can serve as a basis for  
8 willfulness, Sonos’s amendment is not futile. *Corephotonics, Ltd. v. Apple, Inc.*, No. 17-CV-  
9 06457-LHK, 2018 WL 4772340, at \*9 (N.D. Cal. Oct. 1, 2018) (“Post-*Halo*, courts have  
10 recognized that allegations of willful blindness can satisfy the knowledge requirement for willful  
11 infringement.”).

12 Moreover, Sonos has presented factual allegations that Google’s post-suit conduct has  
13 been, and continues to be, willful. TAC ¶¶ 64-65. In particular, Sonos has alleged that since the  
14 day the original complaint was filed on September 29, 2020, and every day thereafter until now,  
15 Google has intentionally, knowingly, and willfully infringed the ’033 and ’966 Patents. *Id.*  
16 Likewise, Sonos has alleged that since the day the first amended complaint was filed on February  
17 17, 2021, and every day thereafter until now, Google has intentionally, knowingly, and willfully  
18 infringed the ’885 Patent. *Id.* And Sonos has also alleged that despite knowledge of the patents  
19 and knowledge of Sonos’s infringement allegations thereof, Google has done nothing since the  
20 original and first amended complaints were filed to stop infringing these patents. Again, these  
21 factual allegations must be accepted as true. Because post-suit knowledge of a patent and  
22 infringement thereof can serve as a basis for willfulness, Sonos’s amendment is not futile. *See,*  
23 *e.g., Fluidigm Corp.*, 2020 WL 1433178, at \*3 (finding “the allegations permit the plausible  
24 conclusion that defendant’s post-suit conduct was willful” because “[n]ow with knowledge of  
25 (alleged) infringement, defendant’s marketing efforts *become* willful”) (emphasis in original).

26 Thus, there is no evidence – let alone strong evidence – that Sonos’s proposed  
27 amendments regarding Google’s willful infringement of the ’966, ’033, and ’885 Patents are  
28 futile.

1                                **2.     The Indirect Infringement Amendments Are Not Futile**

2             Google also cannot provide any evidence that Sonos’s proposed amendments regarding  
3     Google’s indirect infringement of the ’966, ’033, and ’885 Patents are futile.

4             As a preliminary matter, the same *knowledge of infringement* that forms the basis of  
5     Sonos’s willful infringement allegations is equally applicable to Sonos’s claims for indirect  
6     infringement. Dkt. 156 at 11 (“Everything discussed above for willfulness applies here.”).  
7     Accordingly, for the reasons set forth above with respect to pre-suit knowledge for Sonos’s  
8     willfulness allegations, Sonos has adequately pled pre-suit knowledge for purposes of indirect  
9     infringement and thus Sonos’s amendments are not futile in this respect either.

10            To the extent necessary for purposes of addressing Google’s arguments concerning  
11    specific intent to infringe (which did not appear to be adopted or accepted by this Court in its  
12    order granting Google’s motion to dismiss, *see generally* Dkt. 156), Sonos has also pleaded facts  
13    supporting that Google had a specific intent to cause others to infringe. TAC ¶¶103-07, 139-141,  
14    173-76, 207-210. For this additional reason, Sonos’s amendments are not futile.

15            Moreover, Sonos’s amendments regarding lack of substantial non-infringing use for  
16    contributory infringement are not futile either. In this respect, Sonos has presented factual  
17    allegations that the software *components* provided by Google have no substantial non-infringing  
18    uses. TAC ¶¶109-12, 143-46, 178-81, 212-214.

19            This is true because each of the ’966, ’033, and ’885 Patents has an asserted independent  
20    claim that is an “apparatus” type claim that recites certain programmed capability that must be  
21    found in a device. As Sonos’s factual allegations lay out (TAC ¶¶ 109-12, 143-46, 178-81, 212-  
22    14), a device programmed with such capability is “made”—and thus constitutes an instance of  
23    infringement—each time Google (i) provides (a) the Google Home app to a user’s computing  
24    device for installation (’966 Patent) or (b) the YouTube, YouTube TV, YouTube Kids, YouTube  
25    Music, or Google Play Music app to a user’s computing device for installation (’033 Patent) or  
26    (ii) provides a firmware update to a user’s Cast-enabled media player (’885 Patent). *See, e.g.,*  
27    *Finjan, Inc. v. Secure Computing Corp.*, 626 F.3d 1197, 1204-05 (Fed. Cir. 2010) (“[T]o infringe  
28    a claim that recites capability and not actual operation, an accused device need only be capable of



operating in the described mode.”) (internal quotations omitted); *Fantasy Sports Props., Inc. v. Sportsline.com, Inc.*, 287 F.3d 1108, 1118 (Fed. Cir. 2002). Here, the component at issue is the specific software package (*i.e.*, the accused app or a firmware update), which when installed on a device immediately constitutes an infringing article. *See id.* In this regard, Sonos has presented factual allegations that it is the software package itself that has no substantial non-infringing use, regardless of whether the computing device is capable of engaging in non-infringing functionality (in addition to infringing functionality) with the software installed. Once the software is installed, an infringing device has been made<sup>4</sup> and it is irrelevant that a user may use that infringing device to accomplish other tasks. In other words, there is no non-infringing use for the software package, other than to be installed on computing devices, which once this happens, makes an infringing device. TAC ¶¶ 109-12, 143-46, 178-81, 212-14. Sonos’s factual allegations must be accepted as true. The Court must accept Sonos’s factual allegations as true. Accordingly, Sonos’s amendments pleading factual allegations regarding this software provided by Google not having substantial non-infringing uses are not futile.

Even if the ’966, ’033, and ’885 Patents did not include “apparatus” type claims that are infringed when software provided by Google is installed on an applicable device, the Federal Circuit is clear that, in the context of software, the “component” is the focus of the “non-infringing use” analysis – not the entire infringing article. *See, e.g., Koninklijke Philips N.V. v. Zoll Med. Corp.*, 656 F. App’x 504, 522-25 (Fed. Cir. 2016) (compiling cases); *i4i Ltd. P’ship v. Microsoft Corp.*, 598 F.3d 831, 849, *aff’d*, 564 U.S. 91 (2011) (Fed. Cir. 2010) (“[A] particular tool within a larger software package may be the relevant ‘material or apparatus’ when that tool is a separate and distinct feature.”); *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1321 (Fed. Cir. 2009); *Golden Blount, Inc. v. Robert H. Peterson Co.*, 438 F.3d 1354, 1363 (Fed. Cir. 2006). In this respect, Sonos has pleaded in the alternative that the accused software apps have

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<sup>4</sup> This is because the claims are drawn to capability and not use. No use is required for infringement – only making a device that is capable of carrying out certain features (*i.e.*, downloading or installing the accused apps onto computing devices). *Centillion Data Sys., LLC v. Qwest Commc’ns Int’l, Inc.*, 631 F.3d 1279, 1288 (Fed. Cir. 2011); *Finjan, Inc.*, 626 F.3d at 1204 (“[T]o infringe a claim that recites capability and not actual operation, an accused device need only be capable of operating in the described mode.”).



1 component features, such as the accused “Cast” feature, the accused “Stream Transfer” feature, or  
2 the accused “speaker-group” feature, which form material parts of an infringing article and that  
3 that it is these component features that have no substantial non-infringing uses. TAC ¶¶ 112, 146,  
4 181, 214. Thus, Sonos’s amendments pleading factual allegations regarding the component  
5 software features that are contained in the overall software package provided by Google as not  
6 having substantial non-infringing uses are not futile.

7 Consequently, there is no evidence—much less strong evidence—that Sonos’s proposed  
8 amendments regarding Google’s indirect infringement of the ’966, ’033, and ’885 Patents are  
9 futile.

#### 10 **IV. CONCLUSION**

11 For at least the foregoing reasons, Sonos respectfully requests the Court to grant Sonos  
12 leave to amend its complaint and file the Third Amended Complaint on the case docket.

13 Dated: March 30, 2022

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